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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/458,410	12/10/1999	Mohammad Peyravian	P-4541.004	8813

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EXAMINER

MOORTHY, ARAVIND K

ART UNIT	PAPER NUMBER
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2131

DATE MAILED: 02/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/458,410	Applicant(s) PEYRAVIAN ET AL.	
	Examiner Aravind K. Moorthy	Art Unit 2131	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 December 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 December 1999 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This is in response to the amendment filed on 28 December 2005.
2. Claims 1-19 are pending in the application.
3. Claims 1-19 have been rejected.

Response to Arguments

4. Applicant's arguments with respect to claims 1-19 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-19 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The limitation, in independent claims 1 and 19, "receiving identifying data derived from a document at an outside agency" is not supported by the specification. The burden falls on the applicant to point out in the specification where there is support for this limitation.

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6. Claims 1-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1 and 9 provide for the use of receiving identifying data derived from a document at an outside agency, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

The applicant has not provided any active, positive steps on how the identifying data is derived from a document at an outside agency. After a review of the specification, the examiner has seen no support for deriving identifying data from a document.

7. Claims 1 and 9 are rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Haber et al WO 92/03000.

As to claim 1, Haber et al discloses a method for time-stamping a digital document comprising:

receiving identifying data derived from a document at an outside agency
[pages 13-14];

creating at the outside agency a first receipt based on the identifying data
[pages 14-15];

creating at the outside agency a second receipt, different from the first receipt based on a time indication that indicates when the document was received at the outside agency [pages 16-17];

inserting a linking value into the first and second receipts that links the identifying data in the first receipt with the time indication in the second receipt [pages 21-22];

certifying the first and second receipts at the outside agency using a cryptographic signature scheme [pages 23-24].

As to claims 2 and 10, Haber et al discloses that the identifying data comprises a digital representation of at least a portion of the document [pages 13-14].

As to claims 3 and 11, Haber et al discloses that the identifying data comprises a digital sequence derived by application of a deterministic function to at least a portion of the document [pages 13-14].

As to claims 4 and 12, Haber et al discloses that the digital sequence is a hash value derived by application of a one-way hashing function to at least a portion of the document [pages 13-14].

As to claims 5 and 13, Haber et al discloses that the first receipt comprises at least a portion of the identifying data and a nonce [pages 14-15].

As to claims 6 and 14, Haber et al discloses that the first receipt comprises a digital sequence generated by applying a pre-determined function to the identifying data [pages 14-15].

As to claims 7 and 15, Haber et al discloses that one of the first and second receipts comprises a user identification number associated with a user [pages 21-22].

As to claims 8 and 16, Haber et al discloses that one of the first and second receipts comprises a sequential record number [pages 21-22].

As to claim 9, Haber et al discloses a method for time-stamping a digital document comprising:

transmitting identifying data derived from the document to an outside agency [pages 13-14];

receiving from the outside agency a first receipt signed by the outside agency using a cryptographic signature scheme, the first receipt including a first digital sequence generated based on the identifying data [pages 14-15];

receiving from the outside agency a second receipt signed by the outside agency using a cryptographic signature scheme, the second receipt being different from the first receipt and containing a second digital sequence based on a time indication that indicates when the document was received at the outside agency [pages 21-22]; and

wherein the first and second receipts include a linking value that links the identifying data in the first receipt with the time indication in the second receipt [pages 21-22].

As to claim 17, Haber et al discloses that a common cryptographic signature scheme is used to sign both the first and second receipts [pages 23-24].

As to claim 18, Haber et al discloses that different cryptographic signature schemes are used to sign the first and second receipts [pages 23-24].

As to claim 19, Haber et al discloses that the linking value is a nonce value [pages 21-22].

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aravind K. Moorthy whose telephone number is 571-272-3793. The examiner can normally be reached on Monday-Friday, 8:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz R. Sheikh can be reached on 571-272-3795. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Aravind K Moorthy *AM*
February 2, 2006

Ayaz Sheikh
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